

REMARKS

This is in response to the Office Action mailed on October 21, 2005 and the Advisory Action dated 05/09/2006. In the Office Action, which was made final, all of the claims were rejected. Applicant's Response, dated 12/13/2005 was deemed non-complaint as Applicant's amendments were not underlined. With this Amendment, independent claims 1 and 17 have been properly amended. The application continues to include claims 1, 2, 4-8, 17, 18 and 20-24. Claim 3, 9-16, 19 and 25-38 have been cancelled.

The Office Action maintains the rejection of claims 1, 2, 4, 8, 17, 18, 20 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Ruuttu et al. (WO 01/38005) in view of the Ferri, Jr. U.S. Patent No. 6,085,940 as asserted in the previous Office Action. In maintaining the rejection, the Office Action states that Ruuttu et al. fails to teach the use of a deformable or collapsible bladder type coating solution supply container and then alleges that Ferri, Jr. recognizes a deformable or collapsible based chemical dispensing supply system that dispenses chemical from a source or drum directly to a process area without the need of a pumping system, referring to column 1, lines 4-6 and column 5, lines 44-60.

However, upon review of the Ferri, Jr. patent, the only mention of a collapsible bladder is in column 5, lines 58-60 in which the possibility of a collapsible bladder is mentioned, almost as an afterthought. Specifically, the sentence reads:

"Suitable containers include for example, bulk shipping container, for instance, the standard 55 gallon drum, **as well as collapsible bladders.**" [Emphasis added]

In order for a rejection either under 35 U.S.C. § 102 or 103 to be maintained, the prior art disclosure in an obvious determination must be enabling, that is, the disclosure must disseminate subject matter to the public in a manner such that one skilled in the art could make and operate such a device. *Symbol Technologies Inc. v. Opticon Inc.*, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991). There is no enabling disclosure for a collapsible bladder in the Ferri, Jr. patent. The disclosure in the Ferri, Jr. patent describes a structure in which a 55-gallon drum (a rigid container) is positioned and emptied of its chemical contents. All of the claims of the Ferri, Jr. patent are limited to a drum.

There is no enablement in the Ferri, Jr. patent to claim a collapsible bladder.

For example, the 55-gallon drum is positioned within a pressurized tank having a door that opens so that a rigid drum may be positioned inside the tank. There is absolutely no disclosure in how such a pressurized tank could accept a collapsible bladder filled with a liquid through such a door since a collapsible bladder would deform due to internal pressures from the liquid to a shape such that it is not understood how such a deformed bladder could even be positioned within the pressurized tank. Furthermore, the chemical content of the rigid drum is dispensed through a dip tube 16. There is absolutely no disclosure on how a dip tube may be inserted into a flexible bladder without the chemical contents flowing out of the flexible bladder. The entire disclosure in the Ferri, Jr. patent is specific for a rigid 55-gallon drum and there is no enabling disclosure for a flexible bladder.

It is conceded that a nonenabling disclosure may be used as evidence of obviousness for all it fairly suggests to one of ordinary skill in the art. *Id.* @ 1247. However, the Ferri, Jr. patent suggests no more than a dictionary containing the phrase “flexible bladder”.

In addition, since the Ferri, Jr. patent has no enabling disclosure, then there can be no suggestion or motivation in the Ferri, Jr. patent based on the mere mention of a flexible bladder to combine a flexible bladder with the structure shown in Ruuttu et al. The only way that the mere mention of flexible bladder in the Ferri, Jr. patent is combinable with the structure of Ruuttu et al. is through applicant’s disclosure.

As discussed in the Response to the previous Office Action, prior art references must be viewed as a whole. A person of ordinary skill in a particular art of interest (lens coating) will not likely know about prior art in a different unrelated field of technology (emptying out 55 gallon drums). As the Federal Circuit explained in *State Contracting & Engineering Corp. v. Condotte America, Inc.*, 346 F.3d 1057, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. (Referencing *In re Clay*, 966 F.2d 656 (Fed. Cir. 1992)).

The invention in *In re Clay* related to a process for storing refined liquid hydrocarbon product in a storage tank having a dead volume between the tank bottom and its outlet ports. The

appellant appealed the Board's decision affirming the Examiner's obviousness rejection of this process based on a combination of references, which the appellant charged involved a reference in a non-analogous art field. In determining whether the reference was analogous prior art, the Federal Circuit espoused a two-prong test inquiring:

- (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and
- (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

In re Clay, 966 F.2d @ 658-59, 23 U.S.P.Q. 2d at 1060-61.

The court determined that Clay's field of endeavor concerned storage of refined liquid hydrocarbons, whereas the field of endeavor of the reference in question dealt with extracting crude petroleum. The court also determined that this reference did not reasonably pertain to the particular problem facing Clay. The reference addressed the problem of recovering oil from rock. In contrast, Clay's invention sought to prevent the loss of stored product to tank dead volume while preventing contamination of such product. Finding that the reference was not analogous art, the Federal Circuit reversed the Board's decision of obviousness.

Similarly, in the present situation, the apparatus being claimed is for coating a workpiece with a coating solution with the coating solution flowable back and forth between the coating chamber and the supply container (as now defined by the amended claims). Having the coating solution flow back to the supply container to preserve the coating solution for future coatings is important in protecting the coating solution. In contrast, the Ferri, Jr. patent, although concededly is directed to emptying a container having a chemical solution, the Ferri, Jr. patent is not concerned with having the solution flow back to the supply container. The reason for this is that the Ferri, Jr. patent describes an apparatus which empties bulk containers such as 55-gallon drums of chemical solutions. Therefore, the present situation when viewed by the two-prong test in *In re Clay*, can only result in a determination of non-analogous art. The Ferri, Jr. patent relates to the problem of emptying out such bulk containers which is not relevant to the art of coating apparatus.

In view of the above, it is respectfully requested that the rejection of claims 1, 2, 4, 8, 17, 18, 20 and 24 be withdrawn and the claims allowed.

The Office Action also rejected claims 1, 2, 4, 8, 17, 18, 20 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Ruuttu et al. in view of Hewett U.S. Patent No. 6,039,214 for reasons set forth in the previous Office Action. This Office Action summarily dismisses applicant's argument previously provided by simply stating that "the rejection of the claims under Ruuttu et al. and Hewett is deemed reasonable and proper for reasons cited previously. Furthermore, the proper motivation for combining the teachings of Cranskens with Ruuttu et al. and Hewett has been provided as required by *Graham v. Deere*."

On reviewing the rejection of these claims under Ruuttu et al. in view of Hewett in the previous Office Action, it is believed that *Graham v. Deere* was not applied in the manner set forth in MPEP § 2141. As stated in the MPEP, there are four factual inquiries under *Graham v. Deere* that must be followed for determining obviousness. These inquiries are:

1. Determining the scope and contents of the prior art;
2. ascertaining the differences between the prior art and the claims in issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. evaluating evidence of secondary considerations.

Since applicant has not asserted any secondary considerations, the test becomes a three-prong test. All that the previous Office Action mentions of Hewett is that it recognizes a deformable or collapsible bag based dispensing system that dispenses solvent based coating material from a bag, on a small scale, and prevents air from negatively affecting volatile components of the coating material referring to column 1, lines 16-19 and lines 28-31 of Hewett. Then the Office Action simply states that it is obvious to one of ordinary skill in the art to provide a deformable or a collapsible bag dispensing system as taught by Hewett in place of the coating solution supply container(s) of Ruuttu et al. in order to supply coating solutions to the coating chamber on a small bench sized scale without drying out the coating material due to expose to air.

The sections that are identified in the previous Office Action (column 1, lines 16-19 and

lines 28-31), simply reference the fact that liquid such as paints, cleaners and solvents should be maintained in a container that does not permit air to interact with the volatile components. This is not viewing Hewett fairly as a whole to determine the scope and content of Hewett. Viewing Hewett fairly as a whole, and in view of the amended claims in this application, all that Hewett discloses is a flexible bag from which paint (a volatile liquid) is dispensed. As discussed previously, like Ferri, Jr., Hewett is concerned with simply the dispensing of a liquid. The disclosure in Hewett is not concerned with the problem of coating solutions for repetitive coating of objects that are placed within the coating container and the return of that solution back into a supply container. The Hewett patent relates to the problem of providing a container and filling such a container with paint with absolutely no suggestion of reaccepting the paint back into the container. Fairly viewed, Hewett describes a system having a number of flexible containers of paint from which determined quantities of different colors of paint are dispensed with no reacceptance of the paint back into the bag.

Neither Office Action has shown where the motivation is in Hewett or in Ruutu et al. to make the combination. All either Office Action has done is to vaguely state that motivation has been found. It is believed that the Office Action is simply using Hewett because it discloses a flexible bag and the only way to get to Hewett is to use applicant's disclosure as a guide. No reasoning is given in either Office Action why someone skilled in the art of coating objects would look at paint dispensing bags.

The Office Action also rejected claims 5, 7, 21 and 23 as being unpatentable over Ruutu et al. and Hewett as applied to claims 1, 2, 4, 8, 17, 18, 20 and 24 and in further view of the Cranskens et al. U.S. Patent No. 3,296,951 for the reasons set forth in the previous Office Action. This Office Action comments that the proper motivation for combining the teachings of Cranskens et al. with Ruutu et al. and Hewett had been provided as required by *Graham v. Deere*. However, as discussed above, it is believed that the requirements of *Graham v. Deere* have not been properly applied or not even applied. The underlying combination of Ruutu et al. and Hewett is inappropriate as discussed above. Therefore, it is respectfully requested that the rejection of claims 5, 7, 21, and 23 be reconsidered and the claims allowed.

The Office Action also rejected claims 5, 6, 21 and 22 under 35 U.S.C. § 103 as being unpatentable over Ruutu et al. and Hewett as applied to claims 1, 2, 4, 8, 17, 18, 20 and 24 and in further view of the Thorsheim U.S. Patent No. 4,258,862 for the reasons set forth in the previous Office Action. In this Office Action, it is stated that the rejection of the claims under the underlying combination of Ruutu et al. and Hewett is deemed reasonable and proper and that the proper motivation for combining the teachings of Thorsheim with Ruutu et al. and Hewett has been provided as required by *Graham v. Deere*. As discussed above, the underlying combination of Ruutu et al. and Hewett is inappropriate. In view of the above, it is respectfully requested that the rejection of claims 5, 6, 21 and 22 be withdrawn and the claims allowed.

In view of all of the above, it is believed that all of the claims are now in condition for allowance and reconsideration and allowance are respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

By: 

Kent S. Kokko, Reg. No. 33,931
Office of Intellectual Property Counsel
3M Innovative Properties Company
Telephone No.: (651) 733-3597
Facsimile No.: (651) 736-3833